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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,415	06/24/2004	Alexandre Bouriant	2002P16249WOUS	2074

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Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

DEGA, MURALI K

ART UNIT	PAPER NUMBER
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3621

MAIL DATE	DELIVERY MODE
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11/10/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/500,415	Applicant(s) BOURIANT ET AL.	
	Examiner MURALI DEGA	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50, 52-67 and 99-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50, 52-67 and 99-101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination Under 37 C.F.R. §1.114

1. A request for continued examination ("RCE") under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. §1.114. Applicant's submission filed on 04 February 2010 has been entered.

Acknowledgements

1. This non-final office action responds to the amendment and arguments filed by Applicant on 04 February 2010 in reply to the previous Office action on the merits, mailed 07 October 2009.
2. Claims 50, 52-67 and 99-101 are pending.
3. Claims 50, 52-67 and 99-101 have been examined.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 50, 52-67 and 99, 100 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

6. Claim 50 recites "A system" and describes "an integration platform", "an adaptor base" as well as different "mechanisms", which indicate computer programs only.

"Computer programs claimed as separately testable units or elements *per se*, i.e., the descriptions or expressions of the programs, are not physical 'things.' They are neither computer components nor statutory processes, as they are not 'acts' being performed."

MPEP §2106.01 I. Because the claims recite only abstractions that are neither "things" nor "acts," the claims are not within one of the four statutory classes of invention. The Examiner notes that using the broadest reasonable interpretation of "A system", "an integration platform", "an adaptor base" and "mechanisms", the claim is interpreted as software only. Because the broadest reasonable interpretation of "an integration platform", "an adaptor base" and "mechanisms", includes software *per se*, the claim is not within of the four statutory classes of invention and are therefore rejected under 35 U.S.C. § 101.

7. Claims 52-67 and 99, 100 are also rejected for the same reasons above. Particularly, the dependent claims do not add any statutory subject matter.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 50, 53, 54 and 101 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claims 50 and 101 recite “automated production process” in line 6 of page 2 and line 8 of claim 101 in page 4. It is unclear to one of ordinary skill in the art, as to what “automated production process” is and the basis to decide in the alternative, what if it is not an “automated production process”.

11. Claims 50 and 101 recite “a control solution”. The phrase is indefinite because - to one of ordinary skill in this art – the metes and bounds of the phrase cannot be reasonably determined. To support this position, the Examiner notes the following: First, the Examiner has carefully reviewed the original specification and cannot locate a lexicographic definition with the required clarity, deliberateness, and precision. Second, although the Examiner recognizes that each word within the phrase may have a particular meaning, the arrangement of these words within the context of this phrase does not reasonably apprise one of ordinary skill in this art the overall meaning of the claimed phrase. Third, the Examiner has again reviewed all documents of record in conjunction with MPEP §2141.03 including the original specification and claims. Therefore based at least upon the three points noted above and using the required precepts of English grammar, it is the Examiner’s position that the phrase “a control solution” (as used in the context of this particular claim) is neither lexicographically defined by Applicants nor known to those of ordinary skill in this art. However, if Applicants believe that the phrase is old and well known in the art, Applicants should (in their next appropriately filed response) expressly state on the record that the phrase is old and well known in the art and provide appropriate evidence in support thereof (e.g. a U.S. patent). Upon receiving (1) Applicants’ express statement that the phrase is old

and well known in the art and (2) sufficient evidence in support thereof, the Examiner will withdraw this particular 35 U.S.C. §112, 2nd paragraph rejection.

Allowable Subject Matter

12. Claims 50 and 101 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 101 and 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

13. Applicant's arguments with respect to claim 50 have been considered but are not persuasive.

14. The Examiner has contacted the Applicant's representative, attorney Janet D. Hood on October 20th, 2010.

15. The Examiner indicated allowable subject matter if the claims were rewritten to overcome the 35 U.S.C. 101 and 112 2nd paragraph rejections by October 26th, 2010. No response was received by said date.

16. Because the Applicant did not submit the amended claims, this non-final action is set forth maintaining the 35 U.S.C. 101 and 112 2nd paragraph rejections.

Conclusion

17. Applicants are respectfully reminded that any suggestions or examples of claim

language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. To be especially clear, any suggestion or example provided in this Office Action (or in any future office action) does not constitute a formal requirement mandated by the Examiner.

a. Should Applicants decide to amend the claims, Applicants are also reminded that—like always—no new matter is allowed. The Examiner therefore leaves it up to Applicants to choose the precise claim language of the amendment in order to ensure that the amended language complies with 35 U.S.C. § 112 1st paragraph.

b. Independent of the requirements under 35 U.S.C. § 112 1st paragraph, Applicants are also respectfully reminded that when amending a particular claim, all claim terms must have clear support or antecedent basis in the specification. See 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o). Should Applicants amend the claims such that the claim language no longer has clear support or antecedent basis in the specification, an objection to the specification may result. Therefore, in these rare situations where the amended claim language does not have clear support or antecedent basis in the specification and to prevent a subsequent 'Objection to the Specification' in the next office action, Applicants are encouraged to either (1) re-evaluate the amendment and change the claim language so the claims do have clear support or antecedent basis or, (2) amend the specification to ensure that the claim language does have clear support or antecedent basis. See again MPEP § 608.01(o) (¶3). Should Applicants choose

to amend the specification, Applicants are reminded that—like always—no new matter in the specification is allowed. See 35 U.S.C. § 132(a). If Applicants have any questions on this matter, Applicants are encouraged to contact the Examiner via the telephone number listed below.

18. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to MURALI K. DEGA whose telephone number is (571)270-5394. The Examiner can normally be reached on Monday to Thursday 7.00AM to 5.30 PM.

19. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew J. Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Murali K. Dega/
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October 27, 2010

/EVENS J. AUGUSTIN/

Primary Examiner, Art Unit 3621